

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT  
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**Docket Number (Optional)  
21223/0211061-US0

First named inventor: Cindy KOHANEK

Application No: 09/904,425

Art Unit: 2859

Filed: July 12, 2001

Examiner: G. Bradley Bennett

Title: LINEARITY MEASURING APPARATUS FOR WAFER ORIENTATION FLAT

Attention: Office of Petitions

**Mail Stop Petition**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

FAX (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions  
Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus any extensions of time actually obtained.

**APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION**

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee – required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

**1. Petition fee**

☐ Small entity – fee \$ \_\_\_\_\_ (37 CFR 1.17(m)). Applicant claims small entity status.  
See 37 CFR 1.27.

☒ Other than small entity – fee \$ 1,540.00 (37 CFR 1.17(m))

**2. Reply and/or fee**

A. The reply and/or fee to the above-noted Office action in

a concurrently-filed Reply to the Non-Final Office Action  
the form of \_\_\_\_\_  
mailed on July 3, 2002

(identify type of reply):

☐ has been filed previously on \_\_\_\_\_

☒ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of \$ \_\_\_\_\_

☐ has been paid previously on \_\_\_\_\_

☐ is enclosed herewith.

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3. Terminal disclaimer with disclaimer fee

- ☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ \_\_\_\_\_ for a small entity or \$ \_\_\_\_\_ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

**WARNING:**

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

\_\_\_\_\_  
/Louis DeJuidice - 47,522/

Signature

\_\_\_\_\_  
February 2, 2009

Date

\_\_\_\_\_  
Louis J. DeJuidice

Typed or printed name

\_\_\_\_\_  
47,522

Registration Number, if applicable

\_\_\_\_\_  
DARBY & DARBY P.C.  
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Address

\_\_\_\_\_  
(212) 527-7700

Telephone Number

Enclosures: ☒ Fee Payment

☐ Reply

☐ Terminal Disclaimer Form

☒ Additional sheets containing statements establishing unintentional delay

☐ Other: \_\_\_\_\_

**A. THE ABANDONMENT**

Pursuant to Rule 41.37(a), the date of abandonment of the subject application appears to be **Monday, January 6, 2003**,<sup>1</sup> as a result of the applicants' / assignees' unintentional failure to timely file a

<sup>1</sup> The actual date seems to be January 4, 2003. However, since that day was a Saturday, it is believed that the formal abandonment date is January 6, 2003.

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response to the Non-Final Office Action mailed from the PTO on July 3, 2002.<sup>2</sup> As a result of this unintentional abandonment and in accordance with Rule 1.137(b)(1), the assignees have filed concurrently with this Petition a complete and responsive Reply to the Non-Final Office Action, and have likewise paid concurrently the appropriate fees for both the Petition and the Reply. As detailed in this Petition, the entire delay in filing the required Reply from the due date of the PTO Reply at issue, i.e., the Non-Final Office Action, until the filing of this grantable Petition pursuant to Rule 1.137(b), was unintentional.

**B. PARTIES INVOLVED**

1. **Inventors** – Cindy KOHANEK and Gary BABB, who were residents of Oregon and employees of one of the original assignees, Mitsubishi Silicon America Corporation, at the time of filing of the '425 application (collectively "the INVENTORS");

2. **Original and Present Assignees –**

a. **Mitsubishi Materials Silicon Corporation ("MSIL")**

Mitsubishi Materials Silicon Corporation ("MSIL"), 1-5-1 Oote-machi, Chiyoda-ku, Tokyo, JAPAN, the original co-assignee from the INVENTORS, recorded at Reel 012730, Frame 0083; who assigned its rights to Silicon United Manufacturing Corporation ("SUMC"), 1-5-1 Oote-machi, Chiyoda-ku, Tokyo, JAPAN, recorded at Reel 022100, Frame 0078; who assigned its rights to Sumitomo Mitsubishi Silicon Corporation ("SMSC"), 1-2-1 Shibaura, Minato-ku, Tokyo, JAPAN, recorded at Reel 02210, Frame 0367; who assigned its rights to Sumco Corporation ("SUMCO"), 1-2-1 Shibaura, Minato-ku, Tokyo, JAPAN, recorded at Reel 022100, Frame 0428 (collectively "ASSIGNEE SUMCO" or simply "SUMCO"), whose General Manager of the SUMCO Intellectual Property Department, Production & Technology Division, is Mr. Hiroyuki Takeuchi;<sup>3</sup> and

b. **Mitsubishi Silicon America Corporation ("MSAC")**

Mitsubishi Silicon America Corporation ("MSAC"), 1351 Tandem Avenue N.E., Salem, Oregon 97303, the original co-assignee from the INVENTORS, recorded at Reel 012730, Frame 0083; who assigned its rights to SUMCO Oregon Corporation, 1351 Tandem Avenue N.E., Salem, Oregon 97303, recorded at Reel 022100, Frame 0502; who assigned its rights to SUMCO PHOENIX Corporation, 19801 N. Tatum Boulevard, Phoenix, Arizona 85050, recorded at Reel 022170, Frame 0718 (collectively

<sup>2</sup> Papers like this Non-Final Office Action, which are in the '425 PTO Prosecution History on PUBLIC PAIR, are not included as separate Exhibits to the Petition. However, as discussed later, another version of the '425 PTO Prosecution History from law firm files of former prosecuting attorney Jules E. Goldberg, Esq. (Ex. 2), is also provided (Ex. 7). Partial redactions may have been made to some of the papers from this other version of the '425 Prosecution History (Ex. 7) because of irrelevant and/or privileged / workproduct information. While revival of the underlying application is of absolute and paramount importance, in doing so neither the applicants nor the assignees intend to waive, either knowingly or inadvertently, attorney client privilege or the workproduct doctrine. For this reason, including a desire to keep to a minimum the number and size of the attachments to the Petition, extensive quotes from relevant documents are provided in the Petition, as well as in the attached Declarations which identify and authenticate them.

<sup>3</sup> See generally the Declaration of Hiroyuki Takeuchi, Ex. 6 ("TAKEUCHI ¶"). For sake of simplicity and consistency, the Takeuchi Declaration, as well as the three other declarations filed with the Petition, *infra.*, are the same declarations presented in the contemporaneously-filed Revival Petition in Application Serial No. 09/718,659 ("the '659 application"), *infra.*, which Petitioners strongly suggest be considered at the same time by the PTO as this Petition is considered. The "law firm version" of the '659 Prosecution History (Ex. 8) is not included with this Petition, despite reference to it in the Goldberg Declaration, but it is noted here simply to avoid a potential mistaken belief that it is "missing" from the '425 Petition; it is in the '659 Petition.

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"ASSIGNEE SUMCO PHOENIX" or simply "SUMCO PHOENIX"), whose Senior Vice President Human Resources and General Affairs, is Mr. Mark T. Dobbins. SUMCO is the parent of SUMCO PHOENIX;

3. **Japanese Patent Agent** – SUDA PATENT OFFICE, Oak Ikebukuro Bldg. 7F.21-11, Higashi-Ikebukuro 2-chome, Toshima-ku, Tokyo, JAPAN ("SPO") (Mr. Masayoshi Suda, Japanese Patent Attorney and Founder of SPO ("Mr. SUDA"));<sup>4</sup>

4. **Original U.S. Patent Agent** – Reed Smith LLP, formerly at 375 Park Avenue, New York, NY 10152-1799 ("REED SMITH")<sup>5</sup> (Jules E. Goldberg, Esq. (No. 24,408) ("ATTORNEY GOLDBERG"),<sup>6</sup> and Stephen M. Chin, Esq. (No. 39,936); Arthur Dresner, Esq. (No. 36,612); Gerald H. Kiel, Esq. (No. 25,116); Eugene LeDonne, Esq. (No. 35,930); Lloyd McAulay, Esq. (No. 20,423); J. Harold Nissen, Esq. (No. 17,283); and Samir R. Patel, Esq. (No. 44,998)<sup>7</sup>;

5. **Corporate Patent Department of the Original and Present Co-Assignees** – SUMCO Intellectual Property Department, Production & Technology Division, Seavans North, 1-2-1 Shibaura, Minato-ku, Tokyo, JAPAN, including its present General Manager Mr. Hiroyuki Takeuchi, present Manager Toshinobu Miura, and present Assistant Manager Hiroyuki Hasegawa (collectively the "SUMCO IP Department"); and

6. **Current U.S. Patent Agent** - Darby & Darby PC, 250 Greenwich Street, New York, NY 10007-0042 (Louis J. DeJuidice, Esq. (No. 47,522) and Flynn Barrison (No. 53,970)) ("DARBY").

**C. TIMING OF THE PETITION**

MPEP § 711.03(c).II.D. states the following in relevant part:

The Office does not generally question whether there has been an intentional or otherwise impermissible delay in filing an initial petition pursuant to 37 CFR 1.137(a) or (b), when such petition is filed: (A) within 3 months of the date the applicant is first notified that the application is abandoned; and (B) within 1 year of the date of abandonment of the application. Thus, an applicant seeking revival of an abandoned application is advised to file a petition pursuant to 37 CFR 1.137 within 3 months of the first notification that the application is abandoned to avoid the question of intentional delay being raised by the Office (or by third parties seeking to challenge any patent issuing from the application).

Emphasis in the original. It is appreciated that the above MPEP Section emphasizes the word "and" between the three month and one year time periods.

This Petition is being filed by DARBY less than three months after the December 2, 2008 date SPO was "first notified that the application [wa]s abandoned," *infra.*, but six years after the January 6,

<sup>4</sup> See generally the Declaration of Masayoshi Suda, Ex. 1 ("SUDA ¶").

<sup>5</sup> See generally the Declaration of Ruth Montalvo, Ex. 3 ("REED SMITH ¶").

<sup>6</sup> See generally the Declaration of Jules E. Goldberg, Esq., Ex. 2 ("GOLDBERG ¶").

<sup>7</sup> As discussed later in the Petition, ATTORNEY GOLDBERG is no longer with REED SMITH. There does not appear to be any evidence that any of the other attorneys on the Original Power of Attorney to REED SMITH had any involvement in matters material to the Petition. Moreover, as discussed later in the Petition, ATTORNEY GOLDBERG departed REED SMITH at the end of 2007 before joining the firm of Duane Morris LLP ("DUANE MORRIS"), from which he departed at the end of 2008 before joining his present firm of Buckley, Maschoff & Talwalkar LLC ("BMT").

2003 "date of abandonment of the application." Thus, to be on the conservative side and to help assure that the Petition may be granted expeditiously as-filed, as well as the contemporaneously-filed Revival Petition for Application Serial No. 09/718,659 which derives, in most respects, from the same common nucleus of operative facts, the Petition at issue here includes a detailed "showing as to how the delay between the date the applicant was first notified by the Office that the application was abandoned and the filing of a petition under 37 CFR § 1.137 was ... 'unintentional' ... under 37 CFR § 1.137(b)." M.P.E.P. §711.03(c).II.D.<sup>8</sup>

**1. WHEN THE "APPLICANTS" WERE FIRST NOTIFIED THAT THE APPLICATION WAS ABANDONED**

As discussed in more detail below, on November 24, 2008, Mr. SUDA learned during a telephone call from ATTORNEY GOLDBERG of the latter's planned departure at the end of 2008 from DUANE MORRIS to BMT. On the following day, ATTORNEY GOLDBERG confirmed his telephone conversation and asked Mr. SUDA, as ATTORNEY GOLDBERG had done before when he was to depart REED SMITH at the end of 2007, to write a letter requesting DUANE MORRIS to transfer all Intellectual Property ("IP") work entrusted by Mr. SUDA, through his law firm, SPO, to ATTORNEY GOLDBERG at his soon-to-be new law firm, BMT, including the '425 patent application. SUDA ¶¶63; GOLDBERG ¶32.

On November 27, 2008, Mr. SUDA sent a reply email to ATTORNEY GOLDBERG stating, in relevant part, that while Mr. SUDA was awaiting authorization from his clients to transfer the SPO files, such as authorization from SPO client SUMCO, ATTORNEY GOLDBERG should "send [Mr. SUDA] immediately by email or facsimile the numbers and the present status of all of [SPO's] US patents and pending US patent applications recorded by [the] Duane Morris docketing system." Though ATTORNEY GOLDBERG replied to this email on the same day, on December 2, 2008 ATTORNEY GOLDBERG replied by email by providing a spreadsheet showing the then presently pending SPO patent applications and their status, as well as those applications which had issued as U.S. patents from October 1, 2008. The total number of cases on the spreadsheet was 52. SUDA ¶¶64, 66; GOLDBERG ¶¶33-34.

Upon receiving ATTORNEY GOLDBERG's December 2<sup>nd</sup> email and attached spreadsheet, Mr. SUDA asked his SPO staff to carefully compare the GOLDBERG spreadsheet with SPO's own spreadsheet based on SPO's database information system for its IP work outside of Japan (including, but not limited to, the U.S.). As a result, three cases were found to be missing from the SPO spreadsheet and one case was not identifiable. Access to PUBLIC PAIR revealed that one of the three missing cases, assigned to SUMCO, was indicated as being abandoned for failure to respond to a PTO Office Action --

<sup>8</sup> "Where a petition pursuant to 37 CFR 1.137(a) or (b) is not filed within 3 months of the date the applicant is first notified that the application is abandoned, the Office may consider there to be a question as to whether the delay was unavoidable or unintentional. In such instances,

(A) the Office will require a showing as to how the delay between the date the applicant was first notified that the application was abandoned and the date a 37 CFR 1.137(a) petition was filed was "unavoidable"; or

(B) the Office may require further information as to the cause of the delay between the date the applicant was first notified that the application was abandoned and the date a 37 CFR 1.137(b) petition was filed, and how such delay was 'unintentional.'

To avoid delay in the consideration of the merits of a petition under 37 CFR 1.137(a) or (b) in instances in which such petition was not filed within 3 months of the date the applicant was first notified that the application was abandoned, applicants should include a showing as to how the delay between the date the applicant was first notified by the Office that the application was abandoned and the filing of a petition under 37 CFR 1.137 was (A) 'unavoidable' in a petition under 37 CFR 1.137(a); or (B) 'unintentional' in a petition under 37 CFR 1.137(b)."

the '425 application. This was the first time either SPO or Mr. SUDA learned of, or had reason to learn of, the apparent abandonment of the '425 application. SPO and Mr. SUDA were very upset about this information since nothing in the history or records of SPO ever indicated an abandonment of a patent application handled by ATTORNEY GOLDBERG, over a 25-year business relationship Mr. SUDA had with ATTORNEY GOLDBERG, without any corresponding correspondence to SPO about the matter. SUDA ¶¶67-69.

Later on December 2, 2008, Mr. SUDA sent an email to ATTORNEY GOLDBERG stating the following:

"We have reviewed your spreadsheet showing the presently pending applications and their status and found three missing cases therein as follows. The last correspondences between you and us are attached hereto.

- 1) Your Ref.: 500577.20011 Our Ref.: ML6103US US SN 09/718,659
- 2) Your Ref.: 500577.20035 Our Ref.: ML6227US US SN 09/904,425
- 3) Your Ref.: 500577.20089 Our Ref.: ML6436US US SN 11/466,964.

Also, we cannot find a US patent application US SN 12/259,940, Your Ref. JG-SU-5244CON shown in the last line of the spreadsheet. We have not yet received its relevant documents, namely filing report, filing number, etc.

Please let me know the missing reasons and present status of the above-mentioned three cases as well as the information about US patent application US SN 12/259,940 immediately. We look forward to receiving your reply by e-mail."

SUDA ¶¶70; GOLDBERG ¶¶35.

On December 8, 2008, Mr. SUDA telephoned ATTORNEY GOLDBERG about Mr. SUDA's December 2<sup>nd</sup> email and a followup email sent on December 4<sup>th</sup>. During that telephone conversation ATTORNEY GOLDBERG informed Mr. SUDA that, as a consequence of looking into the matter, he learned for the first time that both the '425 and '659 applications were abandoned. ATTORNEY GOLDBERG told Mr. SUDA further that he intended to file petitions to revive these abandoned applications. However, ATTORNEY GOLDBERG did not mention any reasons for the abandonments. SUDA ¶¶71-73; GOLDBERG ¶¶36-39.

Thus, December 8, 2008 was the first time either SPO or Mr. SUDA learned of information from ATTORNEY GOLDBERG that the '425 application was abandoned, confirming what SPO saw from accessing PUBLIC PAIR on December 2, 2008. Before this latter date, neither SPO, Mr. SUDA, nor SUMCO had any knowledge that the '425 application was abandoned. SUDA ¶¶72, 75; GOLDBERG ¶¶37; TAKEUCHI ¶¶26-27.

2. **HOW THE DELAY IN DISCOVERY OF THE ABANDONED STATUS OF THE APPLICATION OCCURRED DESPITE THE EXERCISE OF OF DUE CARE OR DILIGENCE ON THE PART OF THE APPLICANTS**

It is important to understand the background and history to how and why the "applicants" first learned of the abandonment of the '425 application on December 2, 2008, i.e., when the abandonment was first seen on PUBLIC PAIR by Mr. SUDA, whose Japanese firm SPO was delegated responsibility for the '425 application by co-owners SUMCO Corporation and SUMCO PHOENIX through SUMCO, who in turn were delegated through an assignment from the INVENTORS to prosecute the '425 application, which

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in turn was delegated by SUMCO through SPO to ATTORNEY GOLDBERG, who was employed by REED SMITH during most of the prosecution history of the '425 application before ATTORNEY GOLDBERG transferred to DUANE SMITH.

a. **Mr. SUDA and SPO – An Overview**

Mr. SUDA has been a practicing Japanese patent attorney for 30 years who, after receiving a Bachelor of Engineering degree in 1966 from Japan's Gunma University, spent the next 14 years working at The Japan Wool Textile Co., Ltd. in various technical positions. SUDA ¶¶1-7. He then became a practicing Japanese patent attorney for three years with a Japanese patent law firm, called the IDE PATENT OFFICE ("IPO"), doing mainly prosecution work before the Japan Patent Office ("JPO"), prior to his departure in 1983 to start his own firm – SPO, which was located originally within another Japanese patent law firm called the KAWAKAMI PATENT OFFICE ("KPO"), until he moved SPO in 1986 to offices of his own. SUDA ¶¶8-11, 14. SPO still prospers today under Mr. SUDA's management -- 26 years later.

Over these 26 years, SPO has grown from two people – Mr. SUDA and his wife (his first and only office assistant), to today with nine individuals besides Mr. and Mrs. SUDA – four technology-oriented staff members (including a second Japan patent attorney), two staff members dealing primarily with Japan IP matters, two staff members dealing primarily with foreign IP matters (i.e., outside of Japan, including but not limited to the PTO), and an accountant. SUDA ¶¶12, 15, 19-21, 25, 28, 31. SPO also realized considerable growth over these 26 years regarding its IP workload, which has totaled about 5,400 Japanese patent and trademark applications for Japan applicants, 800 foreign applications for Japan applicants, and 170 Japan applications for foreign applicants. *Id.*, ¶31. While SPO's clients began mainly with follow-on clients from Mr. SUDA's respected work for these clients at IPO, including Japan companies Hino Motors Ltd. and Mitsubishi Materials Company ("MMC"), SPO's clientele grew as well over those years, especially with regard to MISL-now-SUMCO, which has accounted for more than 760 of the 5,400 JPO Japan patent applications for Japan applicants. *Id.*, ¶¶12, 31.

In the first years of SPO, Mr. SUDA's main work was filing Japan patent applications, utility model applications, and trademark applications with the JPO. In 1984, MMC asked Mr. SUDA to file several foreign patent applications. As a result, Mr. Kawakami (the founder of KPO), introduced Mr. SUDA to ATTORNEY GOLDBERG as a representative U.S. patent attorney for work with before the PTO, in addition to other foreign patent attorneys. The MMC work was the first time Mr. SUDA was involved in the filing of U.S. patent applications before the PTO. SUDA ¶¶12-13.

b. **SPO Practices and Procedures; and  
Japan and Foreign Docketing Systems**

In 1988, Mr. SUDA built a computerized database management system by himself as a docketing system for SPO, using Japanese relational database software called "KIRI," in which relevant data were entered for only Japan patent and trademark applications handled by SPO. SPO has continued to improve this SPO Japanese docketing system to this day. SUDA ¶16.

Generally speaking, this docketing system was for Japan applications only, and included such information as the application filing date, application filing number, applicant name(s), invention title, inventor name(s), mailing date of JPO office actions, due dates of responses to JPO office actions, filing

dates of responses to JPO office actions, application registration date, application register number, etc. On the basis of this Japan docketing system, SPO started to inform its Japan clients of certain information about their Japan patent applications from SPO system data. For instance, as due dates for responses to JPO office actions became near, SPO informed its Japan clients of the dates by which SPO needed a proposed response to the office actions and, unless that proposed response was received by the proposed date, SPO would send a reminder to the clients until the response was received. SUDA ¶¶17-18.

In 1995, an SPO assistant at the time involved with foreign prosecution matters, Ms. Yamada, developed a computerized database management system for SPO's foreign patent and trademark applications, that was built upon the Japan database Mr. SUDA created for SPO's Japan applications. SPO has continued to improve this foreign prosecution docketing system to this day. Similar to SPO's Japan docketing system, the foreign docketing system (including the U.S. PTO as one of the "foreign" patent offices) included application filing date, application number, applicant name(s), invention title, inventor name(s), mailing date of office actions, response dates to office actions, due dates of argument, filing dates of amendments, publication dates, publication numbers, register dates, register numbers, etc. And, like the Japan docketing system, SPO used these data in the foreign docketing system to inform its Japan clients about their foreign patent applications entrusted to SPO. However, the SPO foreign docketing system at that time did NOT include data about the actual filing date of a response to a foreign office action. Instead, SPO fully trusted the foreign attorneys to file the response by the due date of a foreign office action, if SPO sent its instructions to the attorneys in ample time before the due date. As a result, SPO only required the foreign attorneys to send an acknowledgement of their receipt of SPO's instructions. Accordingly, SPO put its emphasis at that time on providing the foreign attorneys with instructions before the response due date, rather than on confirming the actual filing date of the response from the foreign attorneys. Of course, SPO would eventually learn of the actual filing date of the response upon receiving the filed document by airmail from the foreign attorneys. SUDA ¶¶22-24, 27.

In 2007, SPO slightly modified its docketing system and practices by adding data to the foreign docketing system concerning the actual filing date of a response to a foreign office action. While SPO's trust and confidence with the foreign attorneys with whom it worked as of that point in time had not changed, the main reason for this slight modification resulted from some experiences with ATTORNEY GOLDBERG. In particular, ATTORNEY GOLDBERG had filed some responses to PTO office actions with time extensions that were not previously authorized by SPO or its clients. As a result, SPO began to ask all of its foreign attorneys, including ATTORNEY GOLDBERG, to inform SPO by facsimile or e-mail immediately upon the actual filing of a response. SPO internal procedures were modified further in that, every Tuesday, Mr. SUDA's SPO assistant in charge of foreign prosecution matters was required to deliver, to all of SPO's other assistants, a spreadsheet of the pending patent applications in which foreign patent office actions were outstanding, along with the actual filing date of responses to the office actions. In this manner, any office action on the spreadsheet that did not have an actual filing date after it on the spreadsheet would remain on the spreadsheet. As a result, SPO would hopefully become aware if any foreign attorney who had not yet responded to an outstanding office action. SUDA ¶¶29-30, 43.



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**c. Attorney Goldberg**

As mentioned previously, Mr. SUDA originally met ATTORNEY GOLDBERG in 1985 through an introduction by Mr. Kawakami of KSO for SPO U.S. patent application work for MMC. The MMC work was the first time Mr. SUDA was involved in the filing of U.S. patent applications. As time went on, Mr. SUDA learned through his experiences with ATTORNEY GOLDBERG about not only U.S. patent practice, but also how to write English language letters. Although Mr. SUDA never had a formal business relationship with ATTORNEY GOLDBERG (to the contrary, they have always been completely independent of one another in all of their business affairs), Mr. SUDA has entrusted ATTORNEY GOLDBERG over the years to handle significant IP work for some of Mr. SUDA's clients who have had matters before the PTO. During these years, they have learned a lot from each other, both personally and professionally. Mr. SUDA is very proud of the fact that his clients over the years, with business before the PTO and in other IP matters, have followed ATTORNEY GOLDBERG, through SPO, from his U.S. law firms of Toren McGeady & Goldberg, P.C., to McAulay, Nissen, Goldberg & Kiel LLP, to REED SMITH, and finally to DUANE MORRIS, by continuing to entrust him with legal services. SUDA ¶¶32-36; GOLDBERG ¶¶2-10, 14-17.

ATTORNEY GOLDBERG earned a J.D. degree from the Seton Hall University School of Law in 1970, a Masters of Science in Organic Chemistry from the University of South Carolina in 1963, and a Bachelors of Science in Chemistry from Rutgers University in 1960. He has been a member of the New York State Bar since about 1971 and a Registered Attorney with the PTO since 1967 as a patent agent, and since 1971 as a patent attorney. He has been a member of the Association of the Bar of the City of New York (Member, Committee on Patents, 1981-1984); New York State and American Bar Associations; New York Intellectual Property Law Association; and the American Intellectual Property Law Association. His practice includes IP law, with a focus on patent prosecution, due diligence, and freedom to use opinions in the chemical, biotechnology, and pharmaceutical arts. ATTORNEY GOLDBERG has considerable experience in patent infringement litigation, including defense of ANDA actions. He has also handled trademark infringement litigation and oppositions and appeals before the Federal Circuit Court of Appeals. Further, he sat as an Arbitrator at the Civil Court of the City of New York, Small Claims Part. GOLDBERG ¶¶11-13.

**d. Relationship Between Mr. SUDA, SPO, and SUMCO**

Since 1984, SPO filed about 470 Japan patent applications for SUMCO that have matured into about 160 Japan patents. About 296 foreign patent applications were filed for SUMCO since that time, of which about 133 resulted in issued foreign patents. Based upon this history and the personal relationship Mr. SUDA developed with SUMCO, SUMCO is regarded as an extremely good and trusting SPO client. This relationship has also resulted from the personal way Mr. SUDA has conducted business with SUMCO, and in particular with the SUMCO IP Department. Mr. SUDA has made a point of visiting SUMCO's Japan Institutes and factories two to five times a year since 1984, to interview and meet inventors and staff members of the SUMCO IP Department. The inventor interviews are usually directed to invention proposals and memoranda about proposals for the potential filing of Japan patent applications. If these proposals are worthy of filing, Mr. SUDA usually requires detailed examples and comparative example data from the inventors. He then generally prepares a draft specification and drawings for the

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Japan applications, with assistance from his SPO assistants, which are then reviewed and approved by the SUMCO inventors during each stage of the drafting process. SUDA ¶¶26, 37-40; TAKEUCHI ¶¶8-11, 13-14.

Whenever JPO office actions are received in SPO's SUMCO patent applications, SPO prepares and forwards to the SUMCO IP Department detailed comments about the office actions, usually within about two weeks of their receipt, along with proposed claims / amendments, if necessary. In this manner, SPO has tried to set a deadline for receipt of the SUMCO IP Department reply to the SPO comments and, in those instances where SUMCO does not timely send that reply, SPO sends a reminder to SUMCO until the comments are received. With regard to foreign office actions (including those from the PTO), SPO usually translates into English the SUMCO IP Department's Japanese comments to SPO on those actions, and then prepares and sends English instructions to its foreign patent attorneys in light of the comments -- usually two weeks before the actual due date of a response to the office action. SUDA ¶¶41-42; TAKEUCHI ¶15.

From 1994 to 2003, SPO corresponded with the SUMCO IP Department mostly by facsimile and mail, and partially by e-mail, in the following manner:

- a. SPO-drafted documents to be filed with the JPO or foreign patent offices were sent to SUMCO by facsimile in accordance with the applicable due dates;
- b. the SUMCO-corrected draft documents were returned to SPO by facsimile;
- c. SPO-revised draft documents were sent to SUMCO by facsimile within a couple of days of receipt of the SUMCO corrections;
- d. SUMCO's instructions for filing of the final documents with the JPO or foreign patent offices were sent to SPO by facsimile or e-mail by the SPO deadline;
- e. the filed documents were sent to SUMCO by mail within a couple of days after their actual filing; and
- f. in accordance with SPO docketing systems, SPO tried to report to SUMCO the status of any as-yet-unfiled patent applications or amendments, as well as their actual filing dates and filing numbers, as the case may be, by the first day of each month.

SUDA ¶44; TAKEUCHI ¶¶16-17. From late 2003 to early 2007, SPO corresponded with the SUMCO IP Department mostly by e-mail and regular mail, and partially by facsimile, in the same manner as described above, except that email was generally used other than facsimile (or both methods were used), but for subparagraph (e) above, where mail was still generally used. From early 2007 to the end of 2008, SPO corresponded with the SUMCO IP Department mostly by Virtual Private Network (VPN) and e-mail, and partially by regular mail, in the general manner as described above. SUDA ¶¶45-46; TAKEUCHI ¶¶18-19.

Although personnel at both SPO and the SUMCO IP Department have obviously changed over the years, SPO (mainly through Ms. Yamada and Mr. SUDA) was communicating from mid-1994 to mid-2002 with the SUMCO IP Department mainly through Mr. Hayashi, Mr. Masuda, and Ms. Nagao. From mid-2002 to mid-2003, the SUMCO people were generally Mr. Masuda, Mr. Sudo (a different person than Mr. SUDA, with a similar-sounding family name), Ms. Nagao, and Ms. Kon. From late 2003 to early 2008, it

was Ms. Yamada, Mr. Fusejima, and Mr. SUDA at SPO, with usually Mr. Sudo and Ms. Kon at the SUMCO IP Department. (Mr. SUDA hired Mr. Fusejima as an SPO assistant in March 2006.). And, finally from early-2008 through the end of 2008, it was Mr. Fusejima, Ms. Imai, and Mr. SUDA at SPO, and Mr. Hasegawa and Ms. Kon from SUMCO. SUDA ¶¶47; TAKEUCHI ¶20.

With particular regard to both the '425 and '659 applications, most if not all communications concerning those applications were conducted by and through Mr. Hayashi, Mr. Masuda, and Mr. SUDA. With particular regard to the time period following the Non-Final Office Action mailed from the PTO on July 3, 2002 in the '425 application, there were at least seven back-and-forth communications between SPO and the SUMCO IP Department. Concerning the time period following the Final Office Action mailed from the PTO on December 31, 2002 in the '659 application, through and after the Proposed Amendment of June 20, 2003 was filed in the PTO in response to the Advisory Action of May 20, 2003, there were at least eight back-and-forth communications between SPO and the SUMCO IP Department. SUDA ¶¶49-51; TAKEUCHI ¶¶21-23.

Despite many years of detailed experiences with the SUMCO IP Department with and through the foregoing SUMCO personnel, neither SPO nor Mr. SUDA has ever come to learn, nor did Mr. SUDA feel it important to learn, the docketing system or procedures used by the SUMCO IP Department, at its end, relative to the work performed by SPO for SUMCO. SUDA ¶48.

**e. Transfer of '425 and '659 Application Documents From REED SMITH To DUANE MORRIS**

On December 7, 2007, ATTORNEY GOLDBERG sent an e-mail informing Mr. SUDA that he would be leaving REED SMITH to join DUANE MORRIS at the end of 2007 and that, as a result, he was going to send Mr. SUDA an appropriate draft letter to send to REED SMITH to instruct the firm to transfer its SPO files to DUANE SMITH. Eventually, a final version of this letter was sent by Mr. SUDA to REED SMITH. On January 2, 2008 and as a consequence of Mr. SUDA sending the letter to REED SMITH, ATTORNEY GOLDBERG and Mr. SUDA were copied on a letter from Ms. Natasha M. Robinson, a paralegal at REED SMITH, to a Mr. Stu Steptoff, an individual at DUANE MORRIS, that included what Mr. SUDA understood to be the then pending U.S. patent application files at REED SMITH being transferred to DUANE MORRIS, in 17 boxes with 17 individual lists of the actual files in each of the 17 boxes. According to these lists, the '425 application file was in Box 3 and the '659 application file in Box 14. SUDA ¶¶55-56; GOLDBERG ¶¶24-25.

Mr. SUDA and SPO's Mr. Fusejima carefully compared the patent applications on the 17 individual lists to a list of applications SPO had prepared from the SPO foreign docketing system that reflected what SPO records showed were the pending U.S. applications entrusted at that time to ATTORNEY GOLDBERG at REED SMITH. This comparison at SPO's end revealed that almost all pending U.S. applications on SPO's list were on the 17 individual lists (including the '425 and '659 applications), except that three pending applications and two patented applications from SPO's list were missing from the 17 individual lists. Further correspondence resulted, including a request to Ms. Robinson to find these five missing application files and to send them to DUANE MORRIS, which she apparently did, and acknowledged in a confirmation letter to Mr. Steptoff dated January 7, 2008, that was likewise copied to

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ATTORNEY GOLDBERG and Mr. SUDA. The single box apparently sent with the January 7<sup>th</sup> letter contained application files listed on three individual lists included with the letter. SUDA ¶¶57-58; GOLDBERG ¶26.

Again, Mr. SUDA and Mr. Fusejima carefully checked these latest lists from REED SMITH against the SPO list. However, in doing so, they found on the three individual lists not only the five originally missing application files, but also four others. A subsequent check with SPO's foreign docketing system revealed that yet another application on SPO's system was still missing on the REED SMITH lists from Ms. Robinson. SPO then followed up again with Ms. Robinson about this latest missing application file, which she apparently rectified in another letter copied to ATTORNEY GOLDBERG and Mr. SUDA on January 29, 2008. SUDA ¶59; GOLDBERG ¶27. During ATTORNEY GOLDBERG's entire time at DUANE MORRIS, he did not have retrieved from DUANE MORRIS either of the "paper files" of the '425 or '695 applications, nor did he ever possess or review those files during that entire tenure, except in the limited manner discussed later in this Petition. GOLDBERG ¶¶28, 31, 39.

As an accidental consequence of the checking and re-checking of SPO files during the transfer of files from REED SMITH to DUANE MORRIS, on January 23, 2008 Mr. Fusejima found by accident an old SPO file, on an SPO shelf, that he had not previously handled since joining SPO. The old SPO file was the SPO file of the '659 application. He noticed that the last correspondence in the file from ATTORNEY GOLDBERG, dated June 27, 2003, stated that "[w]e can expect to receive a Notice of Allowance in due course and shall report same to you promptly." Mr. Fusejima noticed also that there had been no correspondence in the file from ATTORNEY GOLDBERG since the June 27<sup>th</sup> correspondence, which he immediately reported to Mr. SUDA, who then instructed him to immediately e-mail ATTORNEY GOLDBERG, on Mr. SUDA's behalf, about the status of the '659 application. Mr. Fusejima did so on January 24, 2008, and immediately reported that to Mr. SUDA and brought him a copy of the email. SUDA ¶60.

In the January 24<sup>th</sup> e-mail to ATTORNEY GOLDBERG, Mr. Fusejima stated the following:

"Your [last] letter to us said "[w]e can expect to receive a Notice of Allowance in due course and shall report same to you promptly"? You moved to Duane Morris, so we must report to SUMCO about all the status [sic: status of all of the applications] you have been in charge of. Please find out and tell us the situation promptly."

Mr. SUDA believed ATTORNEY GOLDBERG and decided to await his reply, but that reply never came to SPO. In hindsight, all Mr. SUDA can say in this regard is that he felt extremely uncomfortable bothering ATTORNEY GOLDBERG about a response to the January 24<sup>th</sup> email, especially since it appeared to indicate only that the Notice of Allowance had not been sent to SPO and that, perhaps, ATTORNEY GOLDBERG had simply forgotten to send it. Apparently, however, the matter from SPO's perspective just slipped between the cracks, at its end, over time until about November 2008 when Mr. SUDA was contacted by ATTORNEY GOLDBERG concerning his intent to leave DUANE MORRIS for BMT. SUDA ¶61, *supra*.

ATTORNEY GOLDBERG does not recall ever receiving or reading the January 24<sup>th</sup> email, but believes that it may be that the email was received at DUANE MORRIS during his first month at the firm

while he was caught up integrating himself into and starting his relationship with DUANE MORRIS. Whatever may be the actual situation, ATTORNEY GOLDBERG simply does not recall ever receiving, seeing, or knowing about the January 24<sup>th</sup> email. GOLDBERG ¶¶29-30.

**f. REED SMITH Practices and Procedures; Docketing System**

Among the database systems and business records used by REED SMITH to organize and manage its legal work on behalf of its many clients, especially on the patent side of the firm's practice, is a system known as "PATTSY." "PATTSY" is a commercially available database system that has been used by REED SMITH for about six years, especially for firm work before the PTO which involves many due dates and other data involved in this specialized aspect of the firm's many practices. A general discussion of a generic "PATTSY" system apparently offered by O P Solutions can be found at <http://www.opsolutions.com/>. REED SMITH ¶¶2, 4; GOLDBERG ¶18. Certain data concerning the '425 and '659 applications in REED SMITH's "PATTSY" database docketing system are discussed later in the Petition.

In addition to the REED SMITH "PATTSY" database system, "paper files" for the '425 and '659 applications were opened and maintained at REED SMITH during the time period those applications were in the possession, custody, and control of REED SMITH (which is no longer the case since they were sent to DUANE MORRIS, *supra.*), as was and is still done as part of the basic practices at REED SMITH for all such patent "paper files." The physical makeup of the REED SMITH patent "paper files" is and remains of the type that is relatively standard in most law firms which handle patent prosecution matters, among other things, in that the physical file is basically a three-fold file, i.e., a left-hand section, a middle section, and a right-hand section, which generally contains papers relating to the underlying patent application, including papers to/from the PTO and to/from the client. REED SMITH ¶¶6; GOLDBERG ¶21.

Even though ATTORNEY GOLDBERG was with REED SMITH for just one year, he became reasonably knowledgeable with the REED SMITH "PATTSY" system, since he used and relied upon it on almost a daily basis in the ordinary course of his business with REED SMITH concerning his IP practice, amongst other ways he and his secretary kept abreast of his docket. ATTORNEY GOLDBERG did not personally enter data into the REED SMITH "PATTSY" system for his work, but he relied in part on the system data to help guide the management and timeliness of his docket, including such information as PTO Office Action mailing dates; PTO response due dates; extendable due dates for those responses; response filing dates; receipt dates of other PTO mailings; REED SMITH attorney names assigned to an application (for him, the system used his initials "JG"); so-called "PATTSY" notes that could be entered manually into "PATTSY," where there was no two-letter code; so-called "call-up" dates when, for example, a "PATTSY" entry should start appearing on an attorney's docket five days before the deadline at issue; etc. As with the REED SMITH "PATTSY" system, ATTORNEY GOLDBERG became quite familiar with the REED SMITH "paper files" since, among other things, these were the same type of files he used before joining REED SMITH, and has used since departing REED SMITH. Further, he used and relied upon the REED SMITH "paper files" on an almost daily basis, in the ordinary course of his business with REED

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SMITH, concerning his IP practice. Indeed, there was almost never a day when a REED SMITH patent "paper file" was not in his office awaiting action by him, or otherwise. GOLDBERG ¶¶19-20, 22.

**g. REED SMITH Records Concerning the '425 and '659 Applications**

After being informed by facsimile from Mr. SUDA on December 12, 2008 that responsibility for the two applications was just delegated to Darby, ATTORNEY GOLDBERG immediately had the REED SMITH "paper files" he had retrieved earlier from DUANE MORRIS' storage facility, that resulted in his discovery of the abandonments, *supra*, he had the "paper files" hand-delivered to Darby later that same day. Exs. 7 and 8 are true and correct PDF versions of the complete REED SMITH "paper files" of the '425 and '659 applications, respectively. GOLDBERG ¶40.

On January 8, 2009, REED SMITH ran database inquiries in its "PATTSY" database system relative to the '425 and '659 applications, and then printed copies of the results from those inquiries. True and correct PDF copies of the printouts are Exs. 4 and 5, respectively. REED SMITH ¶¶3, 5, 7-8. The printouts show the following:

**For the '425 application (Ex. 4)**

- a. a PTO Office Action was issued on July 3, 2002 and a Response was due October 3, 2002, extendable to January 3, 2003. The printout is unclear as to whether a Response was filed, as the response date entered is January 1, 1900;
- b. a Notice of Abandonment was issued March 26, 2003 and docketed for a 2 month response. The printout also includes a note associated with the entry which refers to a Petition filed February 6, 2003, but no reference to the Petition is elsewhere in the printout;
- c. attorney "JG" was assigned to this case (see "Attorneys" field towards the bottom of the printout). The second and third slots in the Attorneys field show "N/A," which means "not applicable;" and
- d. entries for an "AB" (PTO Board of Appeals and Interferences) Notice/Petition (due May 26, 2003) and a Status Check (due September 26, 2003), which were left open and overdue. Both were closed on January 2, 2008; and

**For the '659 application (Ex. 5)**

- a. a PTO Final Office Action was issued on December 31, 2002 and a Response was due March 31, 2003, extendable to June 30, 2003. The printout also indicates that a Response was filed on April 30, 2003;
- b. an Advisory Action was issued on May 20, 2003, according to the PATTSY "notes" for the Notice of Appeal entry, and a second Amendment filed in response on June 20, 2003 with the necessary extension;
- c. a "Call Examiner" entry that was entered manually, as there is no two-letter code in the second box to its left. It was given a base date of June 20, 2003, the same date the second Amendment was filed, and docketed for response 10 days later, meaning the deadline was June 30, 2003, the six-month deadline from the Final Office Action. Additionally, an entry with a "call-up" date of 5 days appears, meaning that the entry should start appearing on the attorney's docket 5 days before the deadline (i.e., June 25, 2003);

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- d. attorney "JG" was assigned to this case (see "Attorneys" field towards the bottom of the printout). The second and third slots in the Attorneys field show "N/A," which means "not applicable;" and
- e. entries for Notice of Appeal and Call Examiner, which were left open and overdue. Both entries indicate deadlines of June 30, 2003, but were closed on January 2, 2008.

REED SMITH ¶¶9-11.

The REED SMITH "paper files" of the '425 and '659 applications, Exs. 7 and 8, show the following, in relevant parts:<sup>9</sup>

For the '425 application (Ex. 4)

- a. Although the file jacket of the '425 application (Ex. 4, p. 1) says, in apparent handwriting, that:
  - i. a "Petition to Revive [was] mailed [on] 2-6-2003;"
  - ii. a Notice of "Abandonment [was] Recd [on] 3-26-03;" and
  - iii. apparently someone was "Awaiting [an] Answer to [a] petition [on] 6-6-2003 (see also REED SMITH ¶10.b., discussed in the preceding paragraph under sub-item (b));
- b. There are no documents in the "paper file:"
  - i. concerning the file jacket entries noted in a.i.-a.iii. directly above; or
  - ii. bearing any dates after December; and

For the '659 application (Ex. 5)

- a. Although the Notice of Allowance in the "paper file" (Ex. 5, pp. 25-29) shows a July 18, 2003 receipt by "Reed Smith Patent Dept." on the reverse side of p. 25 of the Notice, i.e., Ex. 5, p. 26, no related entries are made on the file jacket of the application (Ex. 5, p. 1), nor are there any documents in the file after the date of receipt of the Notice of Abandonment, i.e., after July 18, 2003 (see also REED SMITH ¶11.e., discussed in the preceding paragraph under sub-item (e)).

h. SPO Records Concerning the '425 and '659 Applications

As stated previously, the PTO Notice of Abandonment in the '425 application, mailed by the PTO on March 26, 2003 and apparently received by REED SMITH on the same day (Ex. 4, p. 1; REED SMITH ¶10.b.), Ex. 7, p. 1), is not in any SPO record because it was never received by SPO. The Notice itself states that the abandonment resulted from "[a]pplicant's [sic: applicants'] failure to timely file a proper reply to the [Non-Final] Office [Action] letter mailed on 03 July 2002." The Notice states further that "[t]he Applicant's [sic: Applicants'] representative, Mr. Jules E. Goldberg, was called the week of 3 FEB 2003. At the time, Mr. Goldberg had said that a response would be mailed to the previous office action. However, as of 24 MAR 2003 no reply has been received. Therefore, the application is abandoned."

<sup>9</sup> See n. 2, *supra*, in which SUMCO states clearly, for both ASSIGNEE SUMCO and ASSIGNEE SUMCO PHOENIX, that partial redactions may have been made to some of the papers from the REED SMITH "paper files" of the '425 and '659 applications because of irrelevant and/or privileged / workproduct information, and that while revival of the underlying application is of absolute and paramount importance, in doing so neither the INVENTORS nor the ASSIGNEES intend to waive, either knowingly or inadvertently, attorney client privilege or the workproduct doctrine, relative to these "paper files" / prosecution histories

Again, upon receiving ATTORNEY GOLDBERG's December 2, 2008 email and attached spreadsheet, Mr. SUDA asked his SPO staff to carefully compare the GOLDBERG spreadsheet with SPO's own spreadsheet based on SPO's foreign docketing system. As a result, three cases were found to be missing from the SPO spreadsheet and one case was not identifiable. Access to PUBLIC PAIR by SPO found that one of the three missing cases, assigned to SUMCO, was indicated as abandoned for failure to respond to a PTO Office Action -- the '425 application. This was the first time that either SPO or Mr. SUDA learned of, or had reason to learn of, the apparent abandonment of the '425 application. SUDA ¶¶67-68. The last substantive communication in the SPO records concerning the '425 application is an October 17, 2002 communication from SPO to ATTORNEY GOLDBERG, at REED SMITH, in reply to ATTORNEY GOLDBERG's previous communications of September 20 and 24, 2002 concerning the PTO Office Action of July 3, 2002 (Ex. 7, pp. 252-258), believed to have been received at REED SMITH on October 17, 2002. The last non-substantive communication was a September 26, 2003 communication from ATTORNEY GOLDBERG concerning REED SMITH Invoice No. 1073242, for work performed in July-September 2002.

Likewise, the PTO Notice of Abandonment in the '659 application, mailed by the PTO on July 15, 2003 and apparently received by REED SMITH on July 18, 2003 (Ex. 5, p. 26; REED SMITH ¶¶11,b,c,e; Ex. 8, p. 26), is not in any SPO record because it was never received by SPO. The Notice itself states that (a) the abandonment resulted from ATTORNEY GOLDBERG'S Second Reply to the Final Office Action of December 31, 2002 and the Advisory Action of May 20, 2003, because the Second Reply "does not constitute a proper reply under 37 CFR 1.113(a) ....," and (b) "[i]t is noted that the Examiner telephoned Applicant's [sic: Applicants'] representative [ATTORNEY GOLDBERG] several times in order to place the application in condition for allowance by Examiner's Amendment, but applicant's [sic: applicants'] representative did not return any of the Examiner's phone calls."

As stated previously, as an accidental consequence of the checking and re-checking of SPO files during the transfer of files from REED SMITH to DUANE MORRIS, on January 23, 2008, Mr. Fusejima found by accident an old SPO file, on an SPO shelf, that he had not previously handled since joining SPO. The old SPO file was the SPO file of the '659 application. As a result, Mr. SUDA instructed him to send the following email to ATTORNEY GOLDBERG, which he did on January 24, 2008:

"Your [last] letter to us [in the '659 application] said "[w]e can expect to receive a Notice of Allowance in due course and shall report same to you promptly"? You moved to Duane Morris, so we must report to SUMCO about all the status [sic: status of all of the applications] you have been in charge of. Please find out and tell us the situation promptly."

SPO never received a reply to this January 24<sup>th</sup> email, and ATTORNEY GOLDBERG states he does not recall ever receiving or reading the January 24<sup>th</sup> email, but believes that it may be that the email was received at DUANE MORRIS during his first month at the firm, while he was caught up integrating himself into and starting his relationship with DUANE MORRIS. Whatever may be the actual situation, ATTORNEY GOLDBERG simply does not recall ever receiving, seeing, or knowing about the January 24<sup>th</sup> email. Thus, the last substantive communication in the SPO records concerning the '659 application is the January 24<sup>th</sup> email.



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**i. SUMCO Records Concerning the '425 and '659 Applications**

SUMCO is a very large, multi-national company headquartered in Japan, with offices, factories, laboratories, and other facilities throughout Japan and around the world, that enables the company to operate through many subsidiary and other related companies. A major component of SUMCO's business involves wide and varied IP work and issues, including many patent and trademark matters that arise before the JPO and other foreign patent offices around the world. Accordingly, SUMCO has a large and varied cadre of IP professionals on which it relies, both within the company and outside. The SUMCO IP Department, whose present General Manager is Mr. TAKEUCHI, manages and coordinates these activities in its Japan Headquarters for the entire company. At present, the SUMCO IP Department has about 16 full-time personnel in Japan, including Mr. Toshinobu Miura, Manager of the Department, and Mr. Hiroyuki Hasegawa, Assistant Manager. TAKEUCHI ¶¶2-5.

All SUMCO IP issues are managed and coordinated from the Department in Japan, wherever and however those issues may arise within the company, including its activities and interests in China, Europe, North America, and South America. As a result of these broad and varied responsibilities, especially on the technical and scientific side, the SUMCO IP Department does business with many different and skilled patent attorneys and agents in Japan, and elsewhere, in support of these critically important company activities -- including Mr. SUDA. Ultimate responsibility for the prosecution of the '425 application, despite its joint ownership by SUMCO Corporation and SUMCO PHOENIX Corporation, a SUMCO subsidiary located in the U.S., was and remains with the SUMCO IP Department in Japan. The same applies to the '659 application owned by SUMCO Corporation. TAKEUCHI ¶¶5-7, 12.

The SUMCO IP Department met with Mr. SUDA on December 1, 2008 and, at that meeting, decided to consider a U.S. law firm other than ATTORNEY GOLDBERG's then present law firm, DUANE MORRIS, for SUMCO IP work previously entrusted to him through SPO. Upon looking into the matter further as a result of the abandonment of the '425 and '659 applications, SUMCO was not able to determine why the SUMCO IP Department did not contact SPO at any time about the applications after the last communications the Department received from SPO concerning the applications, *supra*, until the December 12, 2008 date when Mr. SUDA notified the Department of the abandonments. SUMCO can state only the fact that no such contact was made during this extended time period and that, in all likelihood, the reason was that the SUMCO IP Department relied upon its many years of experience and confidence with SPO and Mr. SUDA, to be contacted in a timely fashion about matters of importance concerning SUMCO IP work entrusted to them. SUDA ¶¶52, 65; TAKEUCHI ¶¶24-25.

**i. Not SUMCO, Not SPO, Not Mr. SUDA, and Not ATTORNEY GOLDBERG, Intended the '425 or the '659 Application to Become Abandoned**

Despite the foregoing factual events and circumstances, the individuals and parties material to maintaining the pendency of the '425 and '659 applications have stated in their Declarations, under penalty of perjury, that during the entire time both applications were believed to be pending before the PTO, including the time period from the last communications about which each had knowledge until first learning of the actual abandonments, none intended either application to become abandoned, nor did any have

knowledge or reason to believe either application had become abandoned, before actual knowledge of that fact, including the time period after the actual knowledge when efforts were being undertaken to revive them through a petition. SUDA ¶¶53-54, 78; TAKEUCHI ¶26; GOLDBERG ¶23.

**j. The Revival Process**

On December 9, 2008, Mr. SUDA sent the following email to Darby:

"We have some situation and would like to ask your assistance. There are three US patent applications handled by other US agents. We recently found out that these applications are not on their "pending" application list.

We sent a list (see first PDF attached) to the US agent and asked them about the status of these three applications on the phone. According to them, two of them have been abandoned and they will try to retrieve. Since we haven't received any formal explanation from them, we have no idea why those two applications are abandoned.

According to PAIR, there is no status shown for 1); For 2), the status is 'Abandoned-Failure to Respond to an Office Action'. For 3), pending.

So our question is that if the application is abandoned is it difficult to retrieve? If we file a petition to retrieve the application, is [sic: are] there any special circumstances that the petition is granted for sure? Is it better for a new US agent to file a petition to retrieve the application than the US agent who currently has power? We would appreciate it if you could let us know the possibility of retrieving these cases.

- 1) 米国出願No.09/718,659
- 2) 米国出願No.09/904,425
- 3) 米国出願No.11/466,964;"

SUDA ¶74.

On December 12, 2008, Mr. SUDA sent the following facsimile to ATTORNEY GOLDBERG, as mentioned previously:

"I decided to delegate the above-identified two cases ... to a new agent in order to revive them. The new agent name and other information are as follows: The new agent name: DARBY & DARBY .... I inform you that the new agent contacts you in connection with the two cases;"

SUDA ¶76, GOLDBERG ¶40. From the time Mr. SUDA sent the December 12<sup>th</sup> email, Mr. SUDA has had many email and telephone communications with DARBY about this matter, as well as with SUMCO. In fact, due to the exigencies of the matter, among other things, Mr. SUDA traveled to the U.S. from Japan and personally visited with DARBY in New York City, on December 29, 2008, for an extensive and detailed discussion of the revival effort and the factual circumstances which necessitated that effort, including many of the facts and circumstances set forth in his Declaration. SUDA ¶77. The other parties to the revival process acted with similar promptness.

After receiving the December 12<sup>th</sup> facsimile, ATTORNEY GOLDBERG immediately had the REED SMITH "paper files" hand-delivered to DARBY later that same day. Further, he has communicated several times with DARBY about the applications after their delivery to the firm, including an email he sent on

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January 7, 2009 identifying the names and telephone numbers of personnel at REED SMITH whom he believed might have relevant information concerning the revival process. In addition, ATTORNEY GOLDBERG agreed to supply a Declaration in support of the revival process. Although the original draft of his Declaration was prepared by DARBY, he thoroughly, completely, and promptly reviewed the draft and modified it to assure accuracy, and with his own words or words with which he was comfortable as being his own. GOLDBERG ¶¶41-42. ATTORNEY GOLDBERG's cooperation also led to cooperation and prompt action from REED SMITH and its Declaration.

Thus, the Petition has been prepared with promptness and dispatch, to place it in the form of a grantable petition under Rule 1.137(b).

### **3. The Date of Abandonment**

As stated previously, the Petition is being filed less than three months after the December 2, 2008 date SPO was "first notified that the application [wa]s abandoned," but six years after the January 6, 2003 "date of abandonment of the application." Thus, to help assure that the Petition may be granted expeditiously as-filed, as well as the contemporaneously-filed Revival Petition for the '659 application which derives, in most respects, from the same common nucleus of operative facts, the Petition includes a detailed "showing as to how the delay between the date the applicant was first notified by the Office that the application was abandoned and the filing of a petition under 37 CFR § 1.137 was ... 'unintentional' ... under 37 CFR § 1.137(b)." M.P.E.P. § 711.03(c).II.D.

### **D. CONCLUSION**

For the foregoing reasons, and because the entire delay in filing the required Reply from the due date of the PTO Reply at issue, until the filing of this grantable Petition pursuant to Rule 1.137(b), was unintentional, the Petition should be granted, and the concurrently-filed Reply should be processed forthwith.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**LIST OF ATTACHMENTS**

- Exhibit 1 – Declaration of Masayoshi Suda
- Exhibit 2 – Declaration of Jules E. Goldberg, Esq.
- Exhibit 3 – Declaration of Ruth Montalvo
- Exhibit 4 – Reed Smith "PATTSY" January 8, 2009 Database Run for '425 Application
- Exhibit 5 – Reed Smith "PATTSY" January 8, 2009 Database Run for '659 Application
- Exhibit 6 – Declaration of Hiroyuki Takeuchi
- Exhibit 7 – Reed Smith "Paper File" of '425 Application (Filed **ONLY** with '425 Revival Petition)
- Exhibit 8 – Reed Smith "Paper File" of '659 Application (Filed **ONLY** with '659 Revival Petition)